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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/580,404	05/24/2006	Shingo Sakakibara	Q94716	2088
23373 7590 10/31/2008 SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			EXAMINER BUJE, NICOLE M	
			ART UNIT 1796	PAPER NUMBER
			MAIL DATE 10/31/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/580,404

**Applicant(s)**

SAKAKIBARA ET AL.

**Examiner**

NICOLE M. BUIE

**Art Unit**

1796

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3, 4 and 13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3, 4 and 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

The amendment filed 07/21/2008 has been entered. Claims 3, 4, and 13 remain pending in the application. The previous claim objection claim 7 is withdrawn in light of canceling claim 7 in Applicant's amendment. Additionally, the previous objection to the Abstract is withdrawn in light of Applicant's amendment to the abstract.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**Claims 3, 4, and 13** are rejected under 35 U.S.C. 103(a) as being unpatentable over Asahi Glass Co., Ltd. (JP 2002-114884, see machine translation for citation).

**Regarding claim 3**, JP '884 discloses a fluororesin wherein said fluororesin comprises a tetrafluoroethylene/perfluoro (alkyl vinyl ether) copolymer (Claim 1, [0005]) having a perfluoro (alkyl vinyl ether) unit content of 0.5 to 5.0 mole percent relative to all monomer units

constituting the copolymer [0007] (as compared to 2.5 to 4.0 mole percent as required by said claim).

The Office realizes that all of the claimed effects or physical properties are not positively stated by the reference(s). However, the reference(s) teaches all of the claimed ingredients. Therefore, the claimed effects and physical properties, i.e. critical shear rate would implicitly be achieved by a composition with all the claimed ingredients. If it is the applicant's position that this would not be the case: (1) evidence would need to be provided to support the applicant's position; and (2) it would be the Office's position that the application contains inadequate disclosure that there is no teaching as to how to obtain the claimed properties with only the claimed ingredients.

**Regarding claim 4**, JP'884 discloses a fluororesin whose melt flow rate, at 372°C, is 20-70 g/10 min ([0009],[0022]) (as compared to exceeds 60 (g/10 minutes) as required by said claim).

**Regarding claim 13**, JP '884 discloses a fluororesin which is a fluororesin for electric wire insulating [0020]. The recitation of a new intended use (i.e. for electric wire insulating) for an old product does not make a claim to that old product patentable. *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). See MPEP § 2111.02.

### ***Response to Arguments***

Applicant's arguments filed 07/21/2008 have been fully considered but they are not persuasive. The following comments apply:

A) Applicant's argument that the specific critical shear rate and PFVE unit content as claimed in amended claim 3 provide a fluororesin far superior in MIT value (P6) is not persuasive. Applicant's argument that Examples 18-22 of the specification (perfluoro(alkyl vinyl ether) unit content of 3.5, 2.6, 2.6, 2.6 and 2.9 mole%, respectively) show higher MIT values than those of Examples 17, 23 and 24 (perfluoro(alkyl vinyl ether) unit content of 2.0, 1.6 and 1.6 mole %, respectively) (P6) is not persuasive. Applicant's argument that JP '884 discloses a fluororesin having a perfluoro(alkyl vinyl ether) unit, wherein the disclosed range thereof differs from that of the present invention (P7) is not persuasive. Applicant's argument that although JP '884 comprises a fluororesin having a PAVE content of 2 mole% in Examples 1 and 2, the fluororesin is inferior in MIT value (P7) is not persuasive. JP '884 discloses a fluororesin with the amount of perfluoro (alkyl vinyl ether) unit content which encompasses the claimed range, therefore the claimed range is rendered obvious as shown above in claim 3. Furthermore, the Applicant does not show the criticality of the two end points of the claimed range in claim 3, which is 2.5 to 4.0 mole percent of perfluoro(alkyl vinyl ether). Additionally, it is well known in the art that the MIT flex life increases with increasing amounts of PAVE as evidenced by Aten et al. (US 5,760,151) (C7/L45-55). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to use a higher amount of PAVE to increase the MIT flex life.

B) Applicant's argument that JP '365 discloses the critical shear rate, the values measured at 325°C are different from the claimed value measured at 360°C is moot. JP '365 was not used to reject claim 3.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NICOLE M. BUIE whose telephone number is (571)270-3879. The examiner can normally be reached on Monday-Thursday with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on (571)272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/N. M. B./  
Examiner, Art Unit 1796  
10/29/2008

/Marc S. Zimmer/  
Primary Examiner, Art Unit 1796